

REMARKS

Claims 26, 29-39, 46-55 and 94-102 remain in the application for prosecution. New claims 99-102 have been added.

Supporting Declaration

A declaration under 37 C.F.R. § 1.132 is submitted herewith to support the novelty and nonobviousness of the present invention. The declaration is from an Officer of a leading game development corporation.

Claim Rejections – 35 U.S.C. § 102

Claims 26, 29-36, 46-53 and 94-98 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,254,483 to Acres (“Acres”). The Office Action alleges that Acres discloses the invention. The Office Action states that Acres “discloses a method of operating a gaming machine that includes displaying, on a video display . . . a plurality of standard game appearance . . . monitoring real time . . . automatically . . . displaying modified game appearance, the artwork associated with a holiday (2:46-2:52) . . .” (Office Action, page 2.) The Applicant respectfully disagrees on the basis that significant claim features and limitations are missing from Acres. Anticipation is established only when a single prior art reference discloses expressly, or under the principles of inherency, each element of a claimed invention.

Changing The Theme Of A Game

The present invention can be distinguished from Acres by the fact that all the independent claims require the gaming machine to change the thematic game artwork at a predetermined time. In contrast, Acres does *not* change the game theme.

A theme is a variety of elements that, when taken together as a whole, invokes a mental association with a specific subject. A theme could be a holiday theme such as Halloween, Christmas, Valentine's Day, or Thanksgiving. For example, in the case of Halloween, the set of elements could be a witch, a pumpkin, a ghost, a skeleton, etc. Despite their disparity, when these elements are taken together, they invoke an association with a theme: Halloween. Any one of the elements taken alone does not convey a theme.

Although Acres mentions the possibility of altering "game appearance" based on time, Acres says nothing whatsoever about altering thematic game artwork as required by the claims. Acres only mentions "game appearance" in connection with configuration parameters limited to generic appearance items such as "background color, and card decoration. . ." (Acres, column 1, lines 62-64.) Such generic appearance items are *not* associated with any common subject matter (i.e., theme) and, consequently, do not constitute thematic game artwork.

Acres cannot create a theme as none of the generic appearance items mentioned by Acres taken together invoke an association with a specific subject. For example, background color does not constitute a theme. It is only one element and a set of elements is required to establish a theme. The second game appearance item mentioned by Acres is card decoration. Card decoration is, again, merely generic appearance; it does not invoke a theme. Even taken together, background color and card decoration do not constitute a theme, as these elements do not mentally invoke specific subject matter related to a theme.

All the rejected claims include a significant claim limitation not contained in the Acres reference (i.e., changing the theme of the game). Consequently, the Applicant maintains that these claims are novel and non-obvious over Acres. Not only is Acres missing a fundamental element required for the present invention, it is also lacking any suggestion or motivation to include this

missing element. Acres is directed to increasing the wager per unit time – not to providing a more entertaining gaming machine that can be refreshed with new symbols to keep player interest.

Coordinating The Theme Of A Game With A Special Societal Event

The Office Action goes on to state that Acres discloses “automatically . . . displaying the modified game appearance, the artwork being associated with the holiday (2:46-2:52).” (Office Action, page 2.) In fact, however, Acres does not teach modifying the game appearance in association with a holiday. The reference cited by the Office Action simply states that the *wager per unit time can be altered in association with a holiday*. Acres is silent with respect to changing the game theme to coordinate with a holiday or a societal event.

The Office Action goes on to state that for claim 53, “Acres teaches a game machine programmed to alter game display for a timed or calendar events such as holidays (FIG. 5).” In fact, however, it is not the game display that is being changed in association with the holiday but the wager per unit time that is being altered. As it states in the specification, “FIG. 5 is a exemplary time line for a one year period that shows changes in the player cost per unit time in response to the day of the year.” (Acres, column 3, line 52-54.)

Finally, the Office Action states that “Acres also refers to changing other parameters, such as appearance, based on the holiday events (abstract; 3:18-20; 8:49-65, esp. 8:62-65).” The Acres abstract, as well as column 8, lines 49-65, is silent with respect to changing the game appearance in association with a holiday. Acres’ vague statements that “multiple configuration parameters may be monitored and multiple configuration parameters may be changed in response to the monitored variables” certainly does not rise to the level that suggests that the gaming machine theme is changed in association with holidays or other societal events. Holidays are discussed at length within Acres, and yet are strictly confined and limited to describing changing

the wager per unit time for those calendar events. It is clear that Acres does not anticipate changing the thematic game artwork to correspond to a special event as Acres' only concern is making the gaming machine more profitable for the casino during periods of high demand, such as during holidays.

Consequently, claims 30, 34-36, 46, 52, 53 and 96 include a limitation not contained in Acres (i.e., changing the thematic game artwork to correspond to a special event) and the Applicant maintains that these claims are novel and non-obvious over Acres. Not only is Acres missing a fundamental element required for the present invention, it lacks any suggestion or motivation to include this missing element, as Acres is directed to increasing the wager per unit time; not in providing a more entertaining gaming machine by coordinating game symbols with the holiday or other special event.

Claim Rejections - 35 U.S.C. § 103

Claims 37, 38, 54 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Acres in view of IGWB New '97 Games ("IGWB"). One of the basic requirements for a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. Acres and IGWB do not, however, teach or suggest all of the claim limitations of the claimed invention.

Not All Claim Limitations Taught Or Suggested - Claims 37 And 38

The Office Action states that IGWB "discloses using character animation to provide enjoyment to the game" (page 4). This is not the case. IGWB only describes "themed areas" around a bank of gaming machines. IGWB states:

[t]o present slots in a amore interesting way, many casino operators have turned to grouping about 12 to 20 machines into custom designed themed areas . . . themed environments which include three dimensional signs atop slot carousels,

music, and even coordinating furniture . . . the proliferation of casinos . . . has contributed to the use of themed slot areas . . . several elaborately themed slot areas created by Mikohn . . . complete with three dimensional firemen and a dalmatian, and such sound effects as a siren, . . . which contains animal-print seats as well as three-dimensional animals atop the carousel . . . (IGBW, pages 15-16, paragraph starting with “[t]o present slots . . .” to the fourth paragraph on page 16.)

IGWB does not state that the gaming machine itself is displaying thematic game artwork on its visual display. The themed environment described in IGBW relates to decorative physical objects staged around the gaming machine as depicted in the picture. (IGBW, page 16).

Not All Claim Limitations Taught Or Suggested - Claims 54 And 55

With reference to claims 54 and 55, the Office Action states that IGBW “discloses a plurality of modified visual elements that are player selectable” (IGBW, page 11, paragraphs 1-4). The Applicant points out that IGBW is not alluding to visual elements that are modifiable. Rather, IGBW is referring to the industry’s trend away from the use of traditional artwork for visual elements (such as 7’s, cherries, bars, plums, etc.) to non-traditional artwork (e.g., cabooses, etc). IGBW states:

[e]very year manufacturers of slot machines unveil their latest exciting machines in an attempt to refresh customer interest and boost drop. From the player’s perspective, however, the essence of these dazzling machines hasn’t changed much at all. Everybody has to get three sevens. Then they try to reconfigure and call them cherries or cabooses, or whatever, but it is essentially the same thing. (IGBW, page 11, paragraphs 1-2.)

The paragraph cited above indicates that the “reconfiguration” of the visual elements is a result of the periodic introduction of new slot machines. The “reconfiguration” changes discussed in the article is in the context of manufacturing changes that replaces old software with new software that has new thematic elements programmed into the game. The point of the article is that manufacturers are introducing new gaming machines with new artwork, not that the gaming machines have modifiable visual elements.

Accordingly, it would not have been obvious to modify Acres in view of IGWB because IGWB does not have the limitation cited in the Office Action. Instead, it appears that the limitations that the Office Action alleges to be present in IGWB have been inadvertently read into the reference based on hindsight using the Applicant's own teachings. Obviousness cannot "be established using hindsight or in view of the teachings or suggestions of the invention." *Ex parte Maguire*, 2002 WL 1801466, *4 (Appendix F) (quoting *Para-Ordnance*, 73 F.3d at 1087, 37 U.S.P.Q.2d at 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)).

If the Examiner wishes to maintain the obviousness rejection with respect to the claimed features clearly missing from Acres and IGWB, the Applicant respectfully requests that the Examiner cite appropriate references that disclose such features. *See* MPEP 2144.03.

New Claims 99-102

Four new claims have been added to the specification. Each of these claims discusses the game symbols (used to display the game's random outcome) and how the symbols may change automatically with time. These new claims including the "symbol" terminology were added as suggested by the Examiner in a previous Office Action.

Conclusion

It is the Applicant's belief that the claims are now in condition for allowance, and action towards that end is respectfully requested.

Application No. 09/679,093
Reply to Office Action dated September 7, 2003

If there are any matters which may be resolved or clarified through a telephone interview,
the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,



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